

REMARKS/ARGUMENTS

The Pending Claims

Claims 15, 16, 24, and 71-76 are pending and are directed to a screening method for a somatic cell nuclear reprogramming substance.

Amendments to the Claims

The claims have been amended to point out more particularly and claim more distinctly the invention. Claims 1-14 and 23-25 have been canceled. Claim 15 has been amended so as not to be dependent on claim 13 and, thereby, ultimately claim 1. Claim 22 has been amended to depend from claim 15.

Claims 71-76 are new and are supported by the specification at, for example, page 5, line 36, through page 7, line 27.

No new matter has been added by way of these amendments to the claims.

Summary of the Office Action

The Office has rejected claims 1-7, 10-12, and 22-25 under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement.

The Office has rejected claims 15 and 16 under 35 U.S.C. § 112, second paragraph, as allegedly unclear.

The Office has rejected claims 1-4, 6, 13, 14, 22, 24, and 25 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent Application Publication 2008/0280362 (Jaenisch et al.).

Reconsideration of these rejections is hereby requested.

Discussion of the Enablement Rejection

The Office acknowledges that the specification is enabling for methods of screening for a somatic cell nuclear reprogramming substance that affects expression of ECAT3, ECAT4, and ECAT5. However, the Office does not believe that the specification provides

enablement for methods of screening for factors that affect expression of ECATs, in general, or ECAT1, ECAT2, ECAT6, ECAT7, ECAT8, and ECAT9, specifically. Therefore, the Office has rejected claims 1-7, 10-12, and 22-25 for allegedly lacking enablement.

In an effort to advance prosecution, Applicants have canceled claims 1-14 and 23-25. Applicants note that claims 15 and 16 were not included in the enablement rejection. While claim 15 has been amended so as not to be dependent on claim 13 and, thereby, ultimately claim 1, the enablement rejection is believed to remain inapplicable to claim 15. The remaining pending claims (i.e., claims 22 and 71-76) depend from claim 15 and, therefore, include all of the limitations of claim 15. Therefore, Applicants request that the enablement rejection be withdrawn.

Discussion of the Indefiniteness Rejection

The Office contends that it is unclear how one would differentiate the effect of the ECAT4 supplied in step (a) from the effect of the test substance (also supplied in step (a)). Therefore, the Office has rejected claims 15 and 16 as allegedly indefinite. This rejection is traversed for the following reasons.

The specification discloses that ES cell functions (e.g., undifferentiated state and pluripotency) are not restored merely by introducing ECAT4 into differentiated ES cells (i.e., somatic cells) (see, e.g., page 39, line 25, through page 40, line 9, and page 76, line 28, through page 77, line 15). This indicates that nuclear reprogramming of somatic cells cannot be achieved by ECAT4 alone (see, e.g., page 39, line 25, through page 40, line 9, and page 76, line 28, through page 77, line 15). Therefore, a test substance that allows the emergence of surviving cells under selection pressure contributes to nuclear reprogramming of somatic cells (even if additional factors may be involved in the reprogramming event).

Accordingly, Applicants believe that the subject matter of the pending claims is sufficiently clear, such that the indefiniteness rejection should be withdrawn.

Discussion of the Section 102(e) Rejections

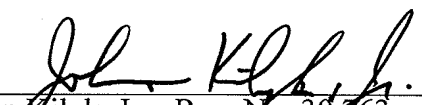
The Office has rejected claims 1-4, 6, 13, 14, 22, 24, and 25 as allegedly anticipated by Jaenisch et al.

As discussed above, claims 1-14 and 23-25 have been canceled in an effort to advance prosecution. Applicants note that that anticipation rejection was not applied to claims 15 and 16, which were indicated by the Office to be free of the prior art. While claim 15 has been amended so as not to be dependent on claim 13 and, thereby, ultimately claim 1, the anticipation rejection is believed to remain inapplicable to claim 15. The remaining claims (i.e., claims 22 and 71-76) depend from claim 15 and, therefore, include all of the limitations of claim 15. Therefore, Applicants request that the anticipation rejection be withdrawn.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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